

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

DEC 13 2002

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDOLPH A. STERN
AND
MICHAEL N. BYLES

Appeal No. 2002-1332
Reissue Application No. 09/558,329

ON BRIEF

Before KRATZ, TIMM, and POTEATE, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

A review of the record presently before us leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the Examiner, via the Office of a Director of the involved Technology Center, to consider the following and to take action not inconsistent with the views expressed herein.

There is an inconsistency in the Answer with regard to the anticipation rejection over U.S. Patent 4,026,129 issued to Sternlieb. In the Final Office Action, the Examiner rejected claims 65 and 67-69 as anticipated by Sternlieb. Yet, in the Answer, the rejection is extended to cover claims 30-36 and 51-56 as well. This change in the statement of rejection is inconsistent with the Issues section of the Answer. The Issues section states that Appellants' statement of the issues in the Brief is correct, but the Brief refers to the Final Office Action in the statement of the issues (Brief at 6) and further the Brief only discusses the rejection with regard to claims 65 and 67-69. The Examiner must remedy the inconsistency.

Should the Examiner re-open prosecution, the Examiner may wish to consider whether Ott renders a larger number of claims unpatentable than presently rejected over Ott. The Examiner has rejected claims, such as claim 58, that require a layer of felt with hydrophobic properties as anticipated by Ott. But Ott describes a stitchbonded wiper with outer layers of polypropylene web and inner layers of cellulose natural fiber web (¶ bridging cols. 2 and 3; Examples 1-2). There is evidence in the record indicating that at least some cellulose natural fibers are hydrophilic (see Appellants' issued patent at col. 3, ll. "natural hydrophilic material such as cotton"; Kyle at col. 3, ll. 8-10). The Examiner should consider if Ott alone or, with other evidence, renders any of the claims requiring hydrophilic layers unpatentable. Should reconsideration result in a conclusion that some of the rejections are merely cumulative, those rejections should be withdrawn as merely cumulative rejections should be avoided. *MIPEP* § 706.02 (8th ed., rev. 1, Aug 2001).

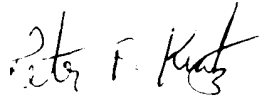
Should the Examiner reopen prosecution, the Examiner may wish to revisit the issue of enablement and further review the question of undue experimentation in light of the relevant *Wands* factors. *See In re Wands*, 858 F.2d 731, 734-35, 8 USPQ2d 1400, 1402 (Fed. Cir. 1988)(Factors to be considered include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability of the art, and (8) the breath of the claims.).

CONCLUSION

In summary, the instant application is remanded to the Examiner to consider the aforementioned issues and to act accordingly.

This application, by virtue of its "special" status requires an immediate action. *MPEP* § 708.01(d) (7th ed., Rev. 1, Feb. 2000). It is important that the Board be informed promptly of any action affecting the appeal in this case (e.g., abandonment, issue, reopening prosecution). An appeal conference as mandated by *MPEP* § 1208 (8th ed., Aug. 2001) must be held before this case is subject to further appeal proceedings.

REMANDED



PETER F. KRATZ
Administrative Patent Judge



CATHERINE TIMM
Administrative Patent Judge



LINDA R. POTEATE
Administrative Patent Judge

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